



08 MAY 2006

46

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Clifford W. Browning
WOODARD EMHARDT
Band One Center/Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137

In re Application of:
GERMAIN, Nicolas : DECISION ON PETITION UNDER
U.S. Application No.: 10/524,624 : 37 CFR 1.47(b)
PCT No.: PCT/CH03/00490 :
International Filing Date: 18 July 2003 :
Priority Date: 19 July 2002 :
Attorney's Docket No.: 16949-2 :
For: SYSTEM FOR EXTRACTING :
INFORMATION FROM A :
NATURAL LANGUAGE TEXT :
:

This decision is issued in response to the "Response To Notification Of Missing Requirements" filed 26 January 2006, treated herein as a petition under 37 CFR 1.47(b) for acceptance of the application without the signature of the sole inventor. Applicant has submitted \$130 as the petition fee; however, the proper petition fee is \$200. Deposit Account No. 23-3030 will be charged the additional \$70 to complete the petition fee.

BACKGROUND

On 18 July 2003, applicant filed international application PCT/CH03/00490. The application claimed a priority date of 19 July 2002 and designated the United States. On 29 January 2004, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 19 January 2005.

On 19 January 2005, petitioner filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and an English translation of the international application.

On 26 July 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an executed oath or declaration acceptable under 37 CFR 1.497 and the surcharge for filing the declaration later than thirty months after the priority date were required.

On 26 January 2006, petitioner filed a response to the Notification Of Missing Requirements. The response included payment of the surcharge for filing the declaration later than thirty months after priority date, and the materials considered herein as a petition under 37 CFR 1.47(b). The petition seeks acceptance of the application without the signature of the sole inventor, whom petitioner states has refused to execute the application papers.

DISCUSSION

A grantable petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages.

Regarding item (1), petitioner has submitted \$130 as the petition fee and authorized a charge to Deposit Account No. 23-3030 for required fees. Pursuant to this authorization, the Deposit Account will be charged the additional \$70 required to complete the \$200 petition fee. Item (1) is therefore satisfied.

Regarding item (2), where it is asserted that the inventor has refused to execute the application papers, section 409.03(d) of the MPEP states that a "copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney." The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made." Here, petitioner has provided a "Statement Of Facts In Support Of Filing On Behalf Of Nonsigning Inventor" executed by Eric Fourboul regarding the efforts made to obtain the signature of the nonsigning inventor Nicolas Germain. Mr. Fourboul states that he sent by mail a copy of the complete application documents to the inventor in April 2005 and that he had repeated telephone conversations with the inventor (both before and after mailing the documents) in which the inventor repeatedly asked for more time to consult with an attorney and to decide whether to sign the required documents. The statement also indicates that in January 2006, pursuant to Mr. Fourboul's instruction, a copy of the complete application documents were presented to the nonsigning inventor by an official Bailiff who asked the inventor to execute the documents. According to the statement, the inventor refused to execute the documents because they were in English (he asserted that he did not speak English) and because he needed to consult with his attorneys first.¹ Finally, Mr. Fourboul states that he is aware that the inventor does speak English.

The materials provided are not sufficient to satisfy item (2). The inventor here refused to sign an English language declaration, asserting that he does not understand English. It would be improper for the inventor to execute a declaration that he could not properly understand (see 37 CFR 1.63(a)(1)). Thus, before the actions described herein can be considered a refusal to execute the application, petitioner would be required to provide an adequate showing that the

¹ This information appears to be derived from the attached summons minutes, but because petitioner has not provided an English translation of the summons minutes, this cannot be confirmed.

inventor knows English well enough to understand the contents of the declaration and specification that he is being asked to execute.

As an alternative to such a showing, petitioner can provide proper firsthand evidence that the inventor has been provided with a copy of the application materials (including the declaration) in the inventor's own language and has refused to execute the declaration (see attached Form PTO/SB/105, a French/English declaration form). It is noted that petitioner should also provide an English translation of any firsthand evidence that the inventor has been presented with such materials and refused to sign them (i.e., summons minutes of the Bailiff).

Until proper supplemental materials are provided, item (2) of a grantable petition is not considered.

Regarding item (3), the petition includes an express statement of the last known address of the nonsigning inventor. Item (3) is therefore satisfied.

Regarding item (4), the petition includes a declaration executed on behalf of the nonsigning inventor by petitioner Go Albert France Sarl (hereinafter "Go Albert"). Specifically, Eric Fourboul, Manager of Go Albert, executed the declaration. Item (4) is satisfied.

Regarding item (5), section 409.03(f) of the MPEP states the following:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that: (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

Here, petitioner has provided a copy of an Assignment of the present invention from the inventor to Albert-Inc. S.A., as well as a copy of a contract (with English translation) by which Albert-Inc., S.A. transferred its rights in this invention to the 37 CFR 1.47(b) applicant, Go Albert. Petitioner has also provided a "Statement Of Law" from a European Patent Attorney who concludes that "[b]y weight of authority in France, title in this invention would be awarded to Go Albert." These materials provide adequate evidence that Go Albert has the required proprietary interest in the present application. Item (5) is therefore satisfied.

Regarding item (6), the petition materials include the required statement that granting of the present petition is necessary to preserve the rights of the 37 CFR 1.47(b) applicant. Item (6) is satisfied.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)" and must include the materials required to satisfy item (2) of a grantable petition, as discussed above and in the applicable sections of the MPEP.

Failure to provide a proper and timely response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

Enclosure: Form PTO/SB/105 (French Language Declaration)

Declaration and Power of Attorney for Patent Application

Déclaration et Pouvoirs pour Demande de Brevet

French Language Declaration

En tant que l'inventeur nommé ci-après, je déclare par le présent acte que:

Mon domicile, mon adresse postale et ma nationalité sont ceux figurant ci-dessous à côté de mon nom.

Je crois être le premier inventeur original et unique (si un seul nom est mentionné ci-dessous), ou l'un des premiers co-inventeurs originaux (si plusieurs noms sont mentionnés ci-dessous) de l'objet revendiqué, pour lequel une demande de brevet a été déposée concernant l'invention intitulée

et dont la description est fournie ci-joint à moins que la case suivante n'ait été cochée:

- a été déposée le _____
 sous le numéro de demande des Etats-Unis ou le _____
 numéro de demande international PCT _____
 _____ et modifiée le _____
 _____ (le cas échéant).

Je déclare par le présent acte avoir passé en revue et compris le contenu de la description ci-dessus, revendications comprises, telles que modifiées par toute modification dont il aura été fait référence ci-dessus.

Je reconnaiss devoir divulguer toute information pertinente à la brevetabilité, comme défini dans le Titre 37, § 1.56 du Code fédéral des réglementations.

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

the specification of which is attached hereto unless the following box is checked:

- was filed on _____
 as United States Application Number or PCT International Application Number _____
 _____ and was amended on _____
 _____ (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

French Language Declaration

Je revendique par le présent acte avoir la priorité étrangère, en vertu du Titre 35, § 119(a)-(d) ou § 365(b) du Code des Etats-Unis, sur toute demande étrangère de brevet ou certificat d'inventeur ou, en vertu du Titre 35, § 365(a) du même Code, sur toute demande internationale PCT désignant au moins un pays autre que les Etats-Unis et figurant ci-dessous et, en cochant la case, j'ai aussi indiqué ci-dessous toute demande étrangère de brevet, tout certificat d'inventeur ou toute demande internationale PCT ayant une date de dépôt précédant celle de la demande à propos de laquelle une priorité est revendiquée.

Prior foreign application(s)
Demande(s) de brevet antérieure(s)

(Number) (Numéro)	(Country) (Pays)

Je revendique par le présent acte tout bénéfice, en vertu du Titre 35, § 119(e) du Code des Etats-Unis, de toute demande de brevet provisoire effectuée aux Etats-Unis et figurant ci-dessous.

(Application No.) (N° de demande)	(Filing Date) (Date de dépôt)

Je revendique par le présent acte tout bénéfice, en vertu du Titre 35, § 120 du Code des Etats-Unis, de toute demande de brevet effectuée aux Etats-Unis, ou en vertu du Titre 35, § 365(c) du même Code, de toute demande internationale PCT désignant les Etats-Unis et figurant ci-dessous et, dans la mesure où l'objet de chacune des revendications de cette demande de brevet n'est pas divulgué dans la demande antérieure américaine ou internationale PCT, en vertu des dispositions du premier paragraphe du Titre 35, § 112 du Code des Etats-Unis, je reconnais devoir divulguer toute information pertinente à la brevetabilité, comme défini dans le Titre 37, § 1.56 du Code fédéral des réglementations, dont j'ai pu disposer entre la date de dépôt de la demande antérieure et la date de dépôt de la demande nationale ou internationale PCT de la présente demande:

(Application No.) (N° de demande)	(Filing Date) (Date de dépôt)

Je déclare par le présent acte que toute déclaration ci-incluse est, à ma connaissance, vérifique et que toute déclaration formulée à partir de renseignements ou de suppositions est tenue pour vérifique; et de plus, que toutes ces déclarations ont été formulées en sachant que toute fausse déclaration volontaire ou son équivalent est passible d'une amende ou d'une incarcération, ou des deux, en vertu de la Section 1001 du Titre 18 du Code des Etats-Unis, et que de telles déclarations volontairement fausses risquent de compromettre la validité de la demande de brevet ou du brevet délivré à partir de celle-ci.

I hereby claim foreign priority under Title 35, United States Code, § 119(a)-(d) or § 365 (b) of any foreign application(s) for patent or inventor's certificate, or § 365(a) of any PCT International application which designated at least one country other than the United States, listed below, and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or PCT International application having a filing date before that of the application on which priority is claimed.

Priority Claimed
Droit de priorité revendiqué

<input type="checkbox"/>	(Day/Month/Year Filed) (Jour/Mois/Année de dépôt)
<input type="checkbox"/>	(Day/Month/Year Filed) (Jour/Mois/Année de dépôt)

I hereby claim the benefit under Title 35, United States Code, § 119(e) of any United States provisional application(s) listed below.

I hereby claim the benefit under Title 35, United States Code, § 120 of any United States application(s), or § 365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of Title 35, United States Code, § 112, I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56 which became available between the filing date of the prior application and the national or PCT International filing date of this application.

(Status) (patented, pending, abandoned)
(Statut) (breveté, en cours d'examen, abandonné)

(Status) (patented, pending, abandoned)
(Statut) (breveté, en cours d'examen, abandonné)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

French Language Declaration

POUVOIRS: En tant que l'inventeur cité, je désigne par la présente l'(les) avocat(s) et/ou agent(s) suivant(s) pour qu'ils poursuive(nt) la procédure de cette demande de brevet et traite(nt) toute affaire s'y rapportant avec l'Office des brevets et des marques: *(mentionner le nom et le numéro d'enregistrement)*.

POWER OF ATTORNEY: As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith: *(list name and registration number)*

Adresser toute correspondance à:

Send Correspondence to:

Adresser tout appel téléphonique à:
(nom et numéro de téléphone)

Direct Telephone Calls to:
(name and telephone number)

Nom complet de l'unique ou premier inventeur	Full name of sole or first inventor		
Signature de l'inventeur	Date	Inventor's signature	Date
Domicile	Residence		
Nationalité	Citizenship		
Adresse postale	Post Office Address		
Nom complet du second co-inventeur, le cas échéant	Full name of second joint inventor, if any		
Signature du second inventeur	Date	Second Inventor's signature	Date
Domicile	Residence		
Nationalité	Citizenship		
Adresse postale	Post Office Address		

(Fournir les mêmes renseignements et la signature de tout co-inventeur supplémentaire.)

(Supply similar information and signature for third and subsequent joint inventors.)